

REMARKS

Claims 1-14 are pending in the application. Claims 1-14 are rejected. The Examiner's objections and rejections are addressed below in substantially the same order as in the office action.

REJECTIONS UNDER 35 USC § 102

Claims 1, 2, and 5-9 are rejected under 35 USC § 102(b) as being anticipated by Holland (US 5,991,920).

The invention of claim 1 comprises "a swimsuit body separable at at least one location by decoupling a corresponding fastening device." This is clearly different from the device discussed in *Holland* where the fastening device 10, 10a couples a portion of the body to the loop 3.

In order for a claimed invention to be unpatentable under 35 USC § 102 over a prior art reference, the prior art must show each and every element of the claim arranged as in the claim. This is clearly lacking in the present case as at least one element of claim 1 is not disclosed in *Holland*.

Accordingly, applicant respectfully submits that claim 1 and claims 2-4 that depend upon claim 1 are patentable under 35 USC § 102 over *Holland*.

Independent claim 5 includes the substantive element of claim 1 discussed above. Accordingly, applicant further submits that claim 5 and claims 6-7 that depend upon claim 5 are

patentable under 35 USC § 102 over *Holland* for the same reasons that claim 1 is patentable under 35 USC § 102 over *Holland*.

Independent claim 8 has been amended to specifically include the fastening device enabling coupling of one portion of the body of the swimsuit to another portion of the body. Independent claim 8 as amended, and claims 9-10 that depend upon claim 8 are thus patentable under 35 USC § 102 over *Holland* for the same reasons that claim 1 is patentable under 35 USC § 102 over *Holland*.

REJECTIONS UNDER 35 USC § 103

Claims 3, 4, and 10-14 are rejected under 35 USC § 103(a) as being unpatentable over either *Holland*.

Claims 3 and 4 depend upon claim 1. In order to sustain a rejection under 35 USC § 103, each and every element of the claim must be disclosed in the prior art of record. In addition, there must be a suggestion of motivation to combine the prior art of record to come up with the claimed invention.

In the present instance, as noted above, at least one element of claim 1 is not disclosed in *Holland*. Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 3 and 4. It is not an obvious design modification to go

from the design of *Holland* in which a portion of the body of the swimsuit is attached to a loop to the present design in which the decoupling is of one portion of the body with respect to another. Applicant respectfully submits that claims 3 and 4 are thus patentable under 35 USC §103 over *Holland*.

Claim 10 is dependent upon claim 9. Applicant respectfully submits that claim 10 is patentable under 35 USC § 103 over *Holland* for the same reasons that claims 3 and 4 are patentable under 35 USC §103 over *Holland*.

With respect to claim 11, the Examiner asserts that

"*Holland* provides a swimsuit (10) comprising a loop (3) adapted to completely encircle a human waist. A body (4) having a front end and a rear end and a rear end. A fastener (10, 10a) for detachable coupling the rear end of the body to the loop and a storage compartment (2) on the front of the swimsuit for compactly stowing the body(4)."

Applicant respectfully disagrees with the Examiner on this assertion. As can be seen in Figs. 1 and 2 of *Holland* (reproduced in the referenced office action), the fastening (10, 10a) is used for coupling the **front** of the body to the loop, **not to the rear of the body**. In addition, the storage compartment (2) of *Holland* is at the **rear** of the body, **not at the front of the body**.

In addition, the Examiner asserts that "one of ordinary skill in the art would have expected Applicant's invention to perform equally well with the front end of the swim suit body having a greater, smaller or equal width than the rear end."

Applicant respectfully submits that this is clearly not the case. As discussed in paragraphs [0003] – [0004], one of the problems addressed by the present invention is that of public nudity. It is inherent in a “thong” swimsuit, the subject of claim 11 and discussed in paragraph [0017] that the front be wider than the rear. Otherwise, the swimsuit will fail to satisfy its purpose which is to meet the standards for public nudity on the beach. This is not simply a design consideration (which would be the subject of a design patent).

Accordingly, applicant respectfully submits that claim 11 and claims 12-14 that depend upon claim 11 are patentable under 35 USC §103 over *Holland*.

CONCLUSION

For all the foregoing reasons, Applicant submits that the application is in a condition for allowance. A credit card authorization in the amount of \$ 55.00 is enclosed for a one month extension. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 13-0010 (HOL-1002CP).

Respectfully submitted,

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